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EXAMINER
BACKER, FIRMIN

ART UNIT	PAPER NUMBER
3621	

DATE MAILED: 06/09/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

		Application No.	Applicant(s)
Office Action Summary		09/636,393	ALLIBHOY ET AL.
		Examiner	Art Unit	
		Firmin Backer	3621	*NW*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>09 August 2000</u>.

2a)☐ This action is **FINAL**.   2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
   closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1- 50</u> is/are pending in the application.

   4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-50</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

   Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

   Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

   a)☐ All   b)☐ Some * c)☐ None of:

   1.☐ Certified copies of the priority documents have been received.

   2.☐ Certified copies of the priority documents have been received in Application No. _____.

   3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
      application from the International Bureau (PCT Rule 17.2(a)).

   * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☒ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
   Paper No(s)/Mail Date _____.

4)☐ Interview Summary (PTO-413)
   Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____.

DETAILED ACTION

This is in response to a letter for patent filed on August 9th, 2000 in which claims 1-50 are

presented for examination. Claims 1-50 are pending in the letter.

Claim Rejections - 35 USC § 101

1.   35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

2.   Claims 1-41 are rejected under 35 U.S.C. 101 because the claimed invention is directed

to non-statutory subject matter.

The basis of this rejection is set forth in a two prong test of:

    (1) whether the invention is within the technological arts; and

    (2) whether the invention produces a useful, concrete and tangible result.

    For a claimed to be statutory, the claimed invention must be within the technological arts.

Mere ideas in the abstract (i.e., abstract idea law of nature, natural phenomena) that do not apply,

involve, use, or advance the technological arts fail to promote the "progress of science and the

useful arts" and therefore are found to be non-statutory subject matter. For a method claim to

pass the muster, the recited method must somehow apply, involve, use, or advance the

technological arts.

    In the present case the inventive concept in claim 1, 8 and 28 only recite an abstract idea.

The recited do not apply, involve, use or advance the technological arts since all s can be

performed in the mind of the user or by use of pencil and paper and no specific technology (e.g.

computer, processor) is expressly recited in the body of the claims. *In re Toma (CCPA 197*

USPQ 852 (1978)).

Although the recited method produces a useful, concrete and tangible result, since the

claimed invention, as a whole, it not within the technological arts as explained above, claim 1

deemed to be directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

3.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the

basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4.   Claims 1-50 are rejected under 35 U.S.C. 102(e) as being anticipated by Ben-Shaul et al

(U.S. PG Pub No. 2002/0010798).

5.   As per claims 1, Ben-Shaul et al teach a method of controlling a financial transaction

between a receiver and a content provider occurring over a network operated by a network

operator, wherein the content provider offers enhanced content programming relating to the

financial transaction, the method comprising intercepting a user request for the enhanced content

programming, the user request originating in the receiver, wherein the intercepting is performed

by a third party *(software or hardware module, edge server, 72) (see figs 7 and 8, paragraphs*

0180, 0214, 0220), permitting *(permitting)* the enhanced content programming *(the content)* to

be provided *(downloading)* to the receiver in response to the user request only if the content

provider is an authorized content provider, wherein the permitting is performed by the third

party *(see paragraph 0426)*; and storing information relating to the enhanced content

programming provided to the receiver in response to the user request, wherein the storing is

performed by the third party *(see paragraphs 0022, 0072, 0107)*.

6.   As per claims 2, Ben-Shaul et al teach a method further comprising determining if the

content provider is authorized by the network operator to offer enhanced content programming

over the network *(see paragraph 0426)*.

7.   As per claims 3, Ben-Shaul et al teach a method further comprising of monitoring for

triggers within the enhanced content programming *(see paragraphs 0190, 0211, 0327)*.

8.   As per claims 4, Ben-Shaul et al teach a method further comprising terminating the user

request after the intercepting if the content provider is unauthorized *(see paragraph 0414)*.

9.   As per claims 5, Ben-Shaul et al teach a method further comprising intercepting a

supplemental user request, the supplemental user request originating in the receiver, wherein the

intercepting is performed by the third party; storing the supplemental user request, wherein the

storing is performed by the third party; and requesting supporting information from the content

provider for the supplemental user request, wherein the requesting is performed by the third

party (*see paragraphs 0022, 0072, 0107*).

10.   As per claims 6, Ben-Shaul et al teach a method further comprising of providing the

supporting information to the receiver upon request (*see paragraph 0152*).

11.   As per claims 7, Ben-Shaul et al teach a method further comprising intercepting a request

to finalize the supplemental user request, the request to finalize the supplemental user request

originating in the receiver, wherein the intercepting is performed by the third party, finalizing

the supplemental user request, wherein the finalizing is performed by the third party; and

supplying the content provider with finalized supplemental user request information (*see*

paragraphs 0022, 0072, 0107).

12.   As per claims 8, Ben-Shaul et al teach a method of motoring a network transaction

between a user receiver and a content provider, the method comprising intercepting a user

request directed at the content provider by the user receiver; appending additional parameters to

the user request; directing the appended user request to the content provider, intercepting a user

request response directed at the user receiver by the content provider, wherein the user request

response comprises at least a portion of the network transaction, extracting transaction

information from the intercepted user request response; and forwarding the user request response

by the third party to the user receiver (*(see figs 7 and 8, paragraphs 0220, 0072, 0107, 0180,*

0214).

13.   As per claims 9, Ben-Shaul et al teach a method further comprising of initially receiving

enhanced content programming from the content provider within the user receiver, and wherein

the user request is formed by of interacting with the content provider through the user receiver

(*see paragraphs 0180, 0214*).

14.   As per claims 10, Ben-Shaul et al teach a method further comprising of recognizing a

trigger within the enhanced content programming, the recognizing performed prior to of

intercepting the user request (*(see figs 7 and 8, paragraphs 0220, 0072, 0107, 0180, 0214*).

15.   As per claims 11, Ben-Shaul et al teach a method wherein of intercepting the user

request further comprises appending an address to a third party controller to the intercepted user

request and directing the intercepted user request to the third party controller, wherein the third

party controller performs of appending additional parameters to the user request (*(see figs 7 and

8, paragraphs 0220, 0072, 0107, 0180, 0214*).

16.   As per claims 12, Ben-Shaul et al teach a method of appending a marker to the user

request response by the content provider, wherein the third party uses the marker to intercept the

user request response (*(see figs 7 and 8, paragraphs 0220, 0072, 0107, 0180, 0214*).

17.   As per claims 13, Ben-Shaul et al teach a method of determining f the content provider is

authorized to provide enhanced content programming to the user receiver (*(see figs 7 and 8,*

paragraphs 0220, 0072, 0107, 0180, 0214).

18.   As per claims 14, 15, Ben-Shaul et al teach a wherein the determining is performed prior

to the first intercepting and after the user request is intercepted by the third party *((see figs 7 and*

8, paragraphs 0220, 0072, 0107, 0180, 0214).

19.   As per claims 16, Ben-Shaul et al teach a method of terminating the network transaction

between the user receiver and the content provider if the content provider is unauthorized *((see*

figs 7 and 8, paragraphs 0220, 0072, 0107, 0180, 0214).

20.   As per claims 17, Ben-Shaul et al teach a method of forwarding the appended user

request to a substitute content provider if the content provider is unauthorized *((see figs 7 and 8,*

paragraphs 0220, 0072, 0107, 0180, 0214).

21.   As per claims 18, Ben-Shaul et al teach a method of storing the extracted transaction

information .

22.   As per claims 19, Ben-Shaul et al teach a method of initiating a purchase from the

content provider by the user receiver; and entering the initiated purchase into a data base

controlled by a third party (*see paragraphs 0180, 0214).*

23.   As per claims 20, Ben-Shaul et al teach a method of displaying information pertaining to

the initiated purchase on a display screen coupled to the user receiver (*see paragraphs 0190,*

0211, 0327).

24.   As per claims 21, Ben-Shaul et al teach a method of displaying at least one advertisement

on the display screen simultaneously with the information pertaining to the initiated purchase

(*see paragraph 0426*).

25.   As per claims 22, Ben-Shaul et al teach a method wherein at least one advertisement

includes linking information to a specific content provider. (*see paragraph 0414*)

26.   As per claims 23, Ben-Shaul et al teach a method of directing a request for additional

information pertaining to the initiated purchase to the content provider, wherein the directing is

performed by the third party receiving the additional information from the content provider by

the third party; and storing the additional information in the third party controlled data base (*(see*

figs 7 and 8, paragraphs 0220, 0072, 0107, 0180, 0214).

27.   As per claims 24, Ben-Shaul et al teach a method of directing a request for updated

information pertaining to the initiated purchase to the content provider, wherein the directing is

performed by the third Party, receiving the updated information from the content provider by the

third party; and storing the updated information in the third party controlled data base *((see figs 7 and 8, paragraphs 0220, 0072, 0107, 0180, 0214).*

28.   As per claims 25, Ben-Shaul et al teach a method of requesting finalization of the initiated purchase by the user receiver; finalizing the initiated purchase with the user receiver, wherein the providing final purchase information to the content provider by the third finalizing is performed by the third party; and party *((see figs 7 and 8, paragraphs 0220, 0072, 0107, 0180, 0214).*

29.   As per claims 26, Ben-Shaul et al teach a method of requesting finalization of the initiated purchase by the user receiver, wherein the requesting is performed prior to the finalizing *(see paragraph 0414).*

30.   As per claims 27, Ben-Shaul et al teach a method of obtaining supplemental information from the user by the third party in order to complete the finalizing *(see paragraph 0414).*

31.   As per claims 28, Ben-Shaul et al teach a method of controlling a network transaction comprising directing enhanced broadcast information via a network to a plurality of receivers, wherein the network is controlled by a network operator, and wherein at least a portion of the enhanced broadcast information is provided by at least one content provider, detecting triggers within the portion of the enhanced broadcast information provided by the at least one content provider, wherein the detecting is performed by a third party; intercepting by the third party a

user request directed at the at least one content provider from a receiver of the plurality of

receivers coupled to the network, directing the intercepted user request to a third party

controller, appending third party parameters to the intercepted user request; directing the

appended user request to the at least one content provider; appending third party markers to a

response to the appended user request, wherein the appending is performed by the at least one

content provider; directing the appended response to the receiver; detecting by the third party

controller the third party markers appended to the response, and storing transaction information

provided by the at least one content provider in the response, wherein the storing is controlled

by the third party controller *((see figs 7 and 8, paragraphs 0220, 0072, 0107, 0180, 0214)*.

32.   As per claims 29, Ben-Shaul et al teach a method of appending information to the

intercepted user request prior to directing the intercepted user request to the third party

controller *(see paragraph 0426)*.

33.   As per claims 30-32, Ben-Shaul et al teach a method, wherein the information appended

to the intercepted user request is comprised of a third party controller address, receiver

capabilities and user profile associated with the receiver *(see paragraphs 0190, 0211, 0327)*.

34.   As per claims 33-36, Ben-Shaul et al teach a method wherein appended third party

parameters comprised of a network specification, a receiver specification, a user profile

associated with the receiver and a set of network operator business rules *((see figs 7 and 8,*

paragraphs 0220, 0072, 0107, 0180, 0214).

35.   As per claims 37, Ben-Shaul et al teach a method of initiating a user financial transaction

through the receiver with the at least one content provider, storing information pertaining to the

user financial transaction in a third party controller data base and displaying at least a portion of

the stored information on a display screen coupled to the receiver *(see paragraph 0414)*.

36.   As per claims 38, 39, Ben-Shaul et al teach a method of displaying at least one

advertisement on the display screen simultaneously with the portion of the stored information

and includes linking information to a specific content provider *(see paragraphs 0190, 0211,*

0327).

37.   As per claims 40, Ben-Shaul et al teach a method requesting additional information on

the user financial transaction from the at least one content provider, wherein the requesting is

performed by the third party controller, receiving the additional information from the at least one

content provider and storing the additional information *(see paragraphs 0190, 0211, 0327)*.

38.   As per claims 41, Ben-Shaul et al teach a method of finalizing the user financial

transaction through the receiver, wherein of finalizing is executed between the receiver and the

third party controller, and providing finalized user financial transaction information to the at least

one content provider by the third party controller *(see paragraphs 0190, 0211, 0327)*.

39.   As per claims 42, Ben-Shaul et al teach a network-based system for providing enhanced

content programming to a user, the system comprising a network a content provider coupled to

the network, wherein the content provider supplies the enhanced content programming a receiver

coupled to the network, the receiver capable of receiving the enhanced content programming, a

display coupled to the receiver for displaying the enhanced content programming to the user;

third party means for intercepting a request initiated by the receiver and directed at the content

provider, third party means for appending operational parameters to the request, third party

means for directing the appended request to the content provider; third party means for

intercepting a response to the request initiated by the content provider; and a database coupled to

the network and the third party means for storing intercepted response information (*(see figs 7

and 8, paragraphs 0220, 0072, 0107, 0180, 0214)*.

40.   As per claims 43, Ben-Shaul et al teach a network-based system wherein third party

means for intercepting the request further comprising third party means for appending an address

for a third party controller to the request, wherein the request is directed at the third party

controller (*see paragraphs 0190, 0211, 0327*).

41.   As per claims 44, Ben-Shaul et al teach a network-based system the third party means for

intercepting the request further comprising third party means for monitoring transactions

between the receiver and the content provider (*see paragraph 0426*).

42.   As per claims 45, Ben-Shaul et al teach a network-based system wherein the third party

monitoring means detects triggers contained within the enhanced content programming *(see*

paragraph 0414).

43.   As per claims 46, Ben-Shaul et al teach a network-based system wherein the third party

controller displays information on transactions between the user and the content provider on the

receiver coupled display *(see paragraph 0426)*.

44.   As per claims 47, Ben-Shaul et al teach a network-based system wherein the third party

controller displays advertisements simultaneously with the transaction information *(see*

paragraphs 0180, 0214).

45.   As per claims 48, Ben-Shaul et al teach a network-based system wherein the third party

controller obtains supplemental information from the content provider pertaining to transactions

initiated between the user and the content provider *(see paragraphs 0180, 0214)*.

46.   As per claims 49, Ben-Shaul et al teach a network-based system wherein the receiver is

selected from the group consisting of set-top boxes, telephones, PDAS, and computers *((see figs*

7 and 8, paragraphs 0220, 0072, 0107, 0180, 0214).

47.   As per claims 50, Ben-Shaul et al teach a network-based system wherein the network is

selected from the group consisting of cable, fiber optics, telephone lines, terrestrial broadcast

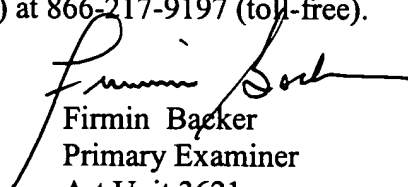systems, and satellite broadcast systems (*see paragraph 0414*).

Conclusion

48.   The prior art made of record and not relied upon is considered pertinent to applicant's

disclosure. (*see form 892*).

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Firmin Backer whose telephone number is (703) 305-0624. The

examiner can normally be reached on Mon-Thu 9:00 AM - 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, James Trammell can be reached on (703) 305-9768. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent

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system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR

system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Firmin Backer
Primary Examiner
Art Unit 3621

June 3, 2004